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7590	06/02/2009	DAVIDSON, DAVIDSON & KAPPEL, LLC 485 Seventh Avenue, 14th Floor New York, NY 10018	EXAMINER	
			DESAI, RACHNA SINGH	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/825,431	Applicant(s) BAKER ET AL.
	Examiner RACHNA S. DESAI	Art Unit 2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

Status

1) Responsive to communication(s) filed on 2/20/09.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-27,41-59 and 71-73 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-27,41-59 and 71-73 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08c)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendments and Remarks filed on 02/20/09.

2. Claims 1-27, 41-59, and 71-73 are currently pending. Claims 1, 18, 41, 49, 57, 71, and 72 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-2, 12, 17-18, 23, 25, 26, 49, 53, 56-59, and 71-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turnbull et al., US 6,092,201, 07/18/00 (filed 01/27/98) in view of Liu et al. ("Liu"), U.S. Patent No. 6,760,752.**

Regarding claim 1, Turnbull discloses a system for extending secure communication operations which meets the limitation, *a digital communication system to denote confidentiality of a digital communication*. See abstract and title.

Turnbull discloses using attribute certificates which convey access privileges or authorization for certain actions set by a user which meets the limitation, ***attach a privilege attribute to a digital communication, the privilege attribute selected by the creator of the digital communication before the digital communication is sent.***

See abstract and column 4, lines 7-30.

Turnbull discloses creating a distribution list of recipients and associating the list with a secure communication which meets the limitation, ***create a privileged distribution list of at least one intended recipient and associate the privileged distribution list with the digital communication when the digital communication is created.*** See column 3, lines 35-45, column 4, lines 25-30, and column 6, lines 28-49.

Turnbull discloses the list of recipients is used to restrict access to the secure communication which meets the limitation, ***restrict access to the privileged digital communication to the at least one intended recipient according to the privileged distribution list.*** See column 3, lines 14-51.

Turnbull discloses a system to extend secure communication ***operations*** which include accessing and routing of secure communications. A user not on the list of intended recipients will not be able to receive the digital communication which meets the limitation, ***restrict routing of the privileged digital communication to the intended recipients and prevent forwarding of the digital communication to an unintended recipient.*** See columns 3-4 and column 6, lines 28-49.

Turnbull discloses a user selects a shared list of intended recipients before a message is sent which meets the limitation, ***wherein intended recipients are selected***

by the creator of the digital communication before the digital communication is sent. See column 3, lines 35-45, column 4, lines 25-30, and column 6, lines 28-49.

Turnbull does not expressly teach *store the privileged digital communication in a segregated location for privileged digital communications on a data storage device.*

However, Liu discloses *storing the privileged digital communication in a segregated location for privileged communications on a data storage device* (See column 21, lines 6-20.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the teachings of Turnbull with the teachings of Liu to store the communication at a segregated location specifically for privileged digital communications because both references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

Regarding claim 2, Turnbull discloses a distribution list of recipients which can comprise multiple intended recipients which meets the limitation, *the at least one intended recipient is a plurality of intended recipients.* See column 3, lines 35-45, column 4, lines 25-30, and column 6, lines 28-49.

Independent claim 18 incorporates substantially similar subject matter as independent claim 1 and is rejected along the same rationale.

With respect to independent claims 49, 71 and 72, please refer to the rationale relied upon to reject independent claim 1, which contains substantially similar subject matter, as discussed above.

Claims 17, 25, 26, and 53 incorporate substantially similar subject matter as independent claim 1 and are rejected along the same rationale.

Claims 57 and 58 incorporate substantially similar subject matter as independent claim 18 and are rejected along the same rationale.

Regarding claims 12, 23, 56, and 59, Turnbull teaches the secure communication is encrypted. See columns 3-5.

5. **Claims 3-11, 13-16, 19-22, 24, 27, 41-48, 50-52, 54-55, and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turnbull et al., US 6,092,201, 07/18/00 (filed 01/27/98) in view of Liu et al. ("Liu"), U.S. Patent No. 6,760,752 and further in view of Dickinson, III et al. ("Dickinson"), U.S. Patent Application Publication No. 2003/0196098.**

Regarding claim 3, Turnbull discloses *a mail server*. See column 3, lines 51-67 and column 4. Turnbull does not disclose a segregated server housing the segregated location for the privileged communication or a program executable to send a copy of the communication to the segregated server.

However, Liu discloses a segregated location for the privileged digital communications, but does not expressly teach a "segregated server".

Dickinson teaches *a segregated server housing the segregated location* (...) (see paras [0034-0038]); *wherein the program is further executable to send a copy of the communication to the segregated server* (see paras [0010], [0034-0038], and [0040-0041]), and a segregated location for privileged digital communications.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

Regarding claims 41, Turnbull discloses:

A method for creating attorney-client privileged digital communication (see Title and Abstract):

creating an electronic communication (See abstract and

columns 2-4 where a user creates an outgoing message)

marking the electronic communication privileged with a privileged attribute which is selected by the creator of the electronic communication before the electronic communication is sent (See abstract and column 4, lines 7-30 where Turnbull discloses using attribute certificates which convey access privileges or authorization for certain actions set by a user).

Turnbull does not expressly teach ***storing the electronic communication in a segregated location for privileged electronic communications on a data storage device.***

However, Liu discloses ***storing the privileged digital communication in a segregated location for privileged communications on a data storage device*** (See column 21, lines 6-20.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the teachings of Turnbull with the teachings of Liu to store the communication at a segregated location specifically for privileged digital communications because both references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the

elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

Turnbull discloses creating a distribution list of recipients and associating the list with a secure communication which meets the limitation, ***associating the privileged distribution list with the digital communication***. See column 3, lines 35-45, column 4, lines 25-30, and column 6, lines 28-49.

Turnbull and Liu do not teach *configuring access rights to the electronic communication*.

Dickinson teaches *configuring access rights to the electronic communication . . . when the electronic communication is created*. (see paras [0009], [0024] and [0030-0031]: The policy modules operate on confidential attachments to e-mails to require either encryption, signature, or both, in order to enforce attorney-client privileges);

Turnbull discloses the secure communications has associated access rights; however, Turnbull/Liu do not expressly teach ***enforcing said access rights by managing access to the electronic communication and controlling the manipulation of its contents based on the privileged distribution list; wherein the access rights include: forwarding of the communication; replying; and replying with copies to pre-selected recipients***.

However, Dickinson discloses configuring access rights to the digital communication when the document is opened and to enforce said access rights by

managing access to the digital communication and controlling the manipulation of its contents (see paragraphs [0009], [0024] and [0030-0031]).

Dickinson does not explicitly disclose forwarding of the communication.

However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to forward the communication for the motivational purpose of comprising the major common functional components of a user-friendly e-mail system.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

Regarding claims 45, Turnbull teaches the secure communication is encrypted.

See columns 3-5.

Regarding claims 4 and 46, Turnbull does not discloses sending a copy as a blind carbon copy; however, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having

ordinary skill in the art to include sending a copy as a blind carbon copy, a characteristic including a department of a corporation using the system, forwarding of the communication, and copying and cutting contents into another location (e.g. Microsoft Outlook, Hotmail, Yahoo! Mail, etc.) for the motivational purpose of comprising the major common functional components of a user-friendly e-mail system.

Regarding claims 5 and 47, Turnbull/Liu does not disclose the segregated location for the privileged digital communication is divided by a common characteristic including a sender, a recipient, and a department of a corporation using the system.

However, Dickinson discloses a communication system (i.e. e-mail) containing a plurality of user specified information fields, such as source field specifying an e-mail address for the source of the message, a destination field specifying one or more destination e-mail addresses for the message, a subject field specifying a subject for the message, a body field specifying the body of the message containing textual and/or graphics data, and an optional attachment field, specifying one or more files to be transmitted with the message. Other user specified fields include, but are not limited to, priority of the message, identity of the sending agent, and the date and time of the message (see paragraph [0019]). Dickinson does not explicitly disclose a characteristic including a department of a corporation using the system. However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include a characteristic including a department of a corporation using the system, forwarding of

the communication for the motivational purpose of comprising the major common functional components of a user-friendly e-mail system.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

Claim 48 incorporates substantially similar subject matter as independent claim 1 and is rejected along the same rationale.

Regarding claims 6 and 50, Turnbull discloses the secure communications has associated access rights; however, Turnbull/Liu do not expressly teach *configuring access rights to the digital communication and to enforce said access rights by managing access to the digital communication and controlling the manipulation of its contents.*

However, Dickinson discloses configuring access rights to the digital communication when the document is opened and to enforce said access rights by

managing access to the digital communication and controlling the manipulation of its contents (see paragraphs [0009], [0024] and [0030-0031]).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

Regarding claim 7, 19, and 51, Turnbull/Liu do not expressly teach different types of access rights; however, Dickinson discloses configuring access rights to the digital communication when the document is opened and to enforce said access rights by managing access to the digital communication and controlling the manipulation of its contents (see paragraphs [0009], [0024] and [0030-0031]). Dickinson does not explicitly disclose forwarding of the communication. However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to forward the communication for the motivational purpose of comprising the major common functional components of a user-friendly e-mail system.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

Regarding claim 8, 20, 42, and 52, Turnbull does not expressly teach the access rights including allowing copying and cutting the contents of the communication and pasting the cut out contents to another location. However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include copying and cutting contents into another location (e.g. Microsoft Outlook, Hotmail, Yahoo! Mail, etc.) for the motivational purpose of comprising the major common functional components of a user-friendly e-mail system.

Regarding claims 9, 21, and 54, Turnbull discloses a privilege attribute associated with a communication but does not teach attaching the attribute to a communication according to predetermined selection criteria. Dickinson discloses executing automatically and attaching the privileged attribute or the executable module

to particular communications according to predetermined selection criteria (see paragraphs [0022-0031].

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

Regarding claims 10, 22, and 55, Turnbull does not teach a confidentiality notice is displayed to the user and acknowledged before displaying the communication. However, Dickinson discloses a confidentiality notice that is displayed to a user and acknowledged by the user before displaying the privileged communication (see para [0039] → i.e. notification actions).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the

combination yielded nothing more than predictable results to one of ordinary skill in the art.

Regarding claim 11, Turnbull and Dickinson do not explicitly teach acknowledging a confidentiality notice by clicking on a GUI button. However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include clicking on a GUI button for the motivational purpose acknowledging a pop-up window (*compare with “confidentiality notice”*).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

Regarding claims 13 and 24, Turnbull does not teach a server object and a client object. Dickinson discloses a server object and a client object (see paragraphs [0034-0037]). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of

providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

Claims 14 and 15 incorporate substantially similar subject matter as independent claim 1 and are rejected along the same rationale.

Regarding claims 16 and 27, Turnbull/Liu/Dickinson do not explicitly teach that the client object is a plug-in to a pre-existing communication system. However, Dickinson discloses the S/MIME protocol to exchange secure e-mail messages (see para [0034]). It is well known to a skilled artisan that most plug-in modules (e.g. Navigator) are based on MIME file types that simply plugs in to the existing system.

Therefore, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include a plug-in to a pre-existing communication system for the motivational purpose of adding a specific feature or service to a larger system. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in

the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

Regarding claim 43, Turnbull discloses a privilege attribute associated with a communication but does not teach attaching the attribute to a communication according to predetermined selection criteria. Dickinson discloses executing automatically and attaching the privileged attribute or the executable module to particular communications according to predetermined selection criteria (see paragraphs [0022-0031]).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

Regarding claims 44, Turnbull does not teach a confidentiality notice is displayed to the user and acknowledged before displaying the communication. However, Dickinson discloses a confidentiality notice that is displayed to a user and

acknowledged by the user before displaying the privileged communication (see para [0039] → i.e. notification actions).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

Regarding claim 73, Turnbull teaches sending a communication to a distribution list but does not expressly state the list is created from one recipient email address in a "To" text box although it was well known in the art at the time of the invention to place email addresses in the "To" text box. Dickinson teaches the email is entered into the "to" text box of a digital communication. See figure 2, "source", element 205. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the system of Turnbull/Liu with Dickinson's segregated server because all the references are from the same field of endeavor of providing secure data transmissions between Internet users. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the

combination yielded nothing more than predictable results to one of ordinary skill in the art.

Response to Arguments

6. Applicant's arguments with respect to claims 1-27, 41-59 and 71-73 have been considered but are moot in view of the new ground(s) of rejection.

In view of the comments above, the rejections are maintained.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHNA S. DESAI whose telephone number is (571)272-4099. The examiner can normally be reached on M-F (8:30AM-6:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rachna S Desai/
Primary Examiner, Art Unit 2176
06/01/09